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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KARL J. DUYCK,
THEODORE E. NALESNIK,
JOHN R. BARANSKI,
CYRIL A. MIGDAL,
and REBECCA F. SEIBERT

Appeal 2008-5105
Application 10/825,065
Technology Center 1700

Oral Hearing Held: Tuesday, December 9, 2008

Before CHUNG K. PAK, PETER F. KRATZ, and
MARK NAGUMO, Administrative Patent Judges

ON BEHALF OF THE APPELLANTS:

JUSTIN L. KRIEGER, ESQ.
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1 The above-entitled matter came on for hearing on
2 Tuesday, December 9, 2008, commencing at 10:02 a.m., at the U.S.
3 Patent and Trademark Office, 600 Dulany Street, 9th Floor, Hearing
4 Room B, Alexandria, Virginia, before Priscilla S. Hopchas, Notary
5 Public.

6 JUDGE PAK: Welcome, Mr. Krieger. Apparently we
7 have a observer. And you may start any time you wish. You have 20
8 minutes. You can assume we know the issue, but before you start, we
9 have a court reporter, Priscilla Hopchas, and she is going to transcribe
10 everything we say here today, and it's going to become a part of the
11 record.

12 So with that, you may start.

13 MR. KRIEGER: Thank you. Good morning. My name
14 is Justin Krieger, and I am counsel for Appellants in this appeal.
15 Before I begin, I have prepared a few slides which I think may be
16 helpful, if I may approach?

17 JUDGE PAK: You may approach the bench.

18 And I presume everything here is supported in the
19 opening Brief.

20 MR. KRIEGER: That's correct.

21 The claimed invention relates to lubricant compositions
22 containing a specific antioxidant mixture, and processes for making
23 such lubricant compositions. The antioxidant mixture contains an
24 alkylated dibutylamine, or ADPA, and a corresponding alkylated
25 acridan.

1 Now, I don't know about you, but for me, I'm very visual,
2 and I think it's helpful to look at page one, and you can see these
3 compounds. On the left there is the ADPA compound, and on the
4 right is the acridan.

5 Now, conventionally antioxidant mixtures for lubricant
6 applications have been prepared by selecting various purified
7 antioxidants off the shelf so to speak, and then taking these purified
8 antioxidants, blending them together and putting them into a
9 lubricant.

10 Now, as illustrated in the reaction on page one, the
11 claimed invention takes a fundamentally different approach to
12 forming a two-part antioxidant mixture by forming the alkylated
13 acridan, the compound on the right, from an ADPA and leaving
14 residual ADPA in with the acridan product.

15 The inventors have discovered, and this is described in
16 the specification, that the residual ADPA and the alkylated acridan
17 work synergistically together to improve oxidative stability over
18 either the ADPA or the acridan separately. This leads to the first
19 issue on appeal, and this on page six. I'm not going to go through all
20 these slides, but you'll see that the claims are reproduced
21 independently in slides three, four and five, and the issues, the
22 primary issues, are on page six.

23 Now, the claims specify that the antioxidant mixture
24 contains an alkylated acridan and a corresponding ADPA from which
25 the acridan was formed. Thus the claims would necessarily require a

1 specific structural relationship between the ADPA and the acridan,
2 contained in the antioxidant mixture.

3 JUDGE NAGUMO: Just to be sure we're on the same
4 page, where is this argument made in the Brief; I recognize it from
5 the Reply Brief, but in the principal Brief the argument seemed to be
6 focused elsewhere, and focused primarily on some process steps. I
7 just want to make sure that we're not -- well, to know what it is we're
8 listening to.

9 MR. KRIEGER: Well, the way this ties into that is that
10 the process steps that were referred to in the initial Brief are
11 specifically what imparts the structure I'm referring to now, the
12 structural relationship between the ADPA and the acridan compound.

13 JUDGE NAGUMO: Yes, but where was this argument
14 made? Let's be clear about that first.

15 MR. KRIEGER: I think the, I don't see anything that's
16 speaking in terms of the language that I'm using today with respect to
17 the structural relationship with the ADPA and the acridan in the
18 initial brief.

19 The initial brief is speaking in terms of process
20 limitations, and then in response to that the Examiner's Answer
21 addressed the process limitations and seemed to disregard them as not
22 relevant and not germane, because, particularly with claim one
23 because claim one was a product by process format, and that's why
24 this issue was clarified in the Reply Brief in response to the
25 Examiner's Answer in which the Examiner did not agree with the

1 process limitations as being germane to this product claim, and that's
2 why it was addressed in that manner.

3 JUDGE NAGUMO: Well, even the process claim on, is
4 it 11, or --

5 MR. KRIEGER: Eleven and 22, I believe.

6 JUDGE NAGUMO: -- and 22, there in the overall
7 process you add a material prepared by this certain process.

8 MR. KRIEGER: This is correct.

9 JUDGE NAGUMO: So that's just another product as far
10 as the claim is concerned claimed by the manner in which it was
11 made so it seems that the Examiner's argument would apply to all of
12 these products.

13 So my question would be, what in the process, with this
14 mixture and then the oxidants, distinguishes over what the Examiner
15 said, which was all you take of them material and you add, it even
16 says, add other kinds of antioxidants, so you go out and add
17 antioxidants that are known, such as this Irganox, which appears to be
18 a butylated and oxytated diphenylamine when its recited in the
19 claims here. So where is the Examiner's error?

20 MR. KRIEGER: Are you speaking in terms of the
21 composition claim or the process claim?

22 JUDGE NAGUMO: Well, both, because I'm wondering
23 why, in process claims we're adding a composition. It's a
24 composition claim that's product by process, but it's still a
25 composition that occurs.

1 MR. KRIEGER: Right, and I think it all comes, whether
2 it's the process claims, but even more particularly for the composition
3 claims I think this is particularly germane, it is the relationship that's
4 required by taking an ADPA, let's say hypothetically you have a
5 methyl substitute, well, let's use your example; butylated octylated.

6 You have a butylated octylated diphenylamine, and you
7 react that forming an acridan. The acridan that's going to be formed
8 is going to be a butylated octylated acridan, and so the mixture, as the
9 claim recites, requires that those two components have that structural
10 relationship, and the rejection simply doesn't address that.

11 It provides one ADPA compound which had one acridan
12 compound, and says that these satisfy the limitations of the claim, but
13 that simply disregards the requirement of the claim language, that
14 they have a structural relationship to one another.

15 You cannot say that the combination, for example, of a
16 methyl alkylated diphenylamine and a butylated octylated acridan,
17 bind those together, that those satisfy the claim limitation, because
18 you simply cannot form butylated octylated acridan from a methyl
19 substituted diphenylamine. You just can't do it.

20 So it's that limitation which in our view has been
21 disregarded, and there's been no rationale provided as far as why one
22 would specifically take an ADPA and an acridan having the structural
23 relationship and combine them together as the claims require.

24 JUDGE NAGUMO: But Wheeler teaches adding a
25 number of different kinds of materials to get the acridan. Alkylated --

1 I'm not going to say the name because -- it says add a class of
2 materials together, so he's not teaching just on a dimethyl acridan.

3 MR. KRIEGER: This is true, but the materials that are
4 described in Wheeler do not satisfy them. For example, the butylated
5 octylated diphenylamine from Deetman, which the Examiner is
6 relying upon. Nowhere within the four corners of Wheeler is there a
7 description about forming a butylated octylated acridan. It's not
8 there.

9 And that's the point, is that Wheeler doesn't satisfy that
10 limitation, and if the Examiner is going to rely upon the butylated
11 octylated diphenylamine, that's fine, but then the Examiner has to
12 show me where you have a butylated octylated acridan compound,
13 and that's simply not described in Wheeler or in any other references
14 I'm aware of.

15 And again, I think this gets back to, Wheeler is doing, and
16 Deetman, for that matter, exactly the conventional way of doing this,
17 which is going to a store, buying off the shelf pure isolated
18 antioxidants, blending them together.

19 It's very different than what we're doing here, which is
20 forming at first instance without a separation step a combination of an
21 alkylated diphenylamine with a similarly corresponding alkylated
22 acridan, and the rejection just doesn't address that.

23 JUDGE KRATZ: And of course this is not, as was just
24 mentioned before, this is an argument you didn't make in your main
25 Brief. It's just presented now, here today, and I guess a little

1 somewhat in your Reply Brief. And why should we entertain that
2 argument?

3 MR. KRIEGER: Again, I think it's because the Examiner
4 disregarded the process limitations, and in the Examiner's Answer,
5 and the purpose of --

6 JUDGE KRATZ: And they didn't do that in the Final
7 Rejection; the Final Rejection, did he relate the --

8 MR. KRIEGER: He did, he did make that approach.

9 JUDGE KRATZ: So you've had the opportunity to make
10 that argument in your opening Brief, and you chose not to.

11 MR. KRIEGER: Well, no decision was made not to.
12 This was handled -- to be fair, procedurally, the original Brief was
13 handled by a different firm, and our firm handled the Reply Brief, so
14 there certainly was no intention to withhold this argument until now.

15 It was just reading this, the claim language was clear to
16 me when I looked at this, working on the Reply Brief, that this was an
17 element, a claim element that is recited in the composition claims and
18 the process claims, and which was not addressed in the --

19 JUDGE KRATZ: And let me get this straight, the
20 butylated octylated acridan, that's not within the generic acridan
21 formula that the primary reference Wheeler discloses?

22 MR. KRIEGER: I think if you -- it may be, if you were
23 to look at the thousands upon thousands of various compounds that
24 fall under the very generic description of acridans, which are recited
25 in Wheeler, but there is no, there is certainly not teaching or
26 suggestion or any rationale that's been provided as to why one would

1 specifically pick that one from the Wheeler reference or anywhere
2 else.

3 JUDGE KRATZ: But your claim is not, basically it's
4 within this, this genus that he has there for acridans?

5 MR. KRIEGER: That I think is an accurate
6 characterization. However, Wheeler makes no reference of the
7 invention which is not just simply that we have acridan, it's the
8 combination of these two species together, and how they work
9 synergistically together. That combination is nowhere found, and
10 there's no hint of it, in Wheeler or in any other reference.

11 JUDGE NAGUMO: Can you direct us to the record
12 where some version of this argument was made to the Examiner, or is
13 this something that you're making to the Office now basically for the
14 first time?

15 MR. KRIEGER: Well, it's my understanding the
16 Examiner could be here today to address this argument if the
17 Examiner chose to do so, so certainly it was open to additional
18 comments, and my understanding is, and perhaps I'm mistaken on
19 this part, but if the Examiner wanted to submit additional paper to
20 that effect, the Examiner could have done so.

21 However, again I think it ties in directly to the process
22 arguments, which have been asserted repeatedly, and which have
23 been disregarded by the Examiner, so it further bolsters that position,
24 and that's why it was addressed in the Reply Brief, again, with the
25 caveat of the procedural history I just described.

26 JUDGE PAK: Any additional evidence or questions?

1 MR. KRIEGER: May I make one additional --

2 JUDGE PAK: Yes, certainly.

3 MR. KRIEGER: And another point here, specifically for
4 the process, I think this is particularly relevant to the process claims,
5 and that is on slide --

6 JUDGE KRATZ: Is this an argument that's made in the
7 Brief?

8 MR. KRIEGER: This is an argument made in the Brief.
9 This is with respect to, in fact Wheeler, for the process claims,
10 teaches exactly the opposite of what we're going after. The claims in
11 the, the process claims speak in terms of, in slightly different ways,
12 leaving residual ADPA into the additive mixture, and Wheeler, from
13 this excerpt which I provided here, discusses specifically carefully
14 fractionating and recrystallizing the acridan, and again, with the
15 conventional line of thought, taking the purified acridan and blending
16 it with various other purified antioxidants in order to for an
17 antioxidant blend.

18 For this reason, also, as the Board is well aware,
19 references must be considered in their entirety, and I think when you
20 consider Wheeler in its entirety, it absolutely cannot be relied upon
21 properly for an obviousness rejection, at least with respect to those
22 process claims, because of those limitations with respect to leaving
23 residual ADPA in the antioxidant mixture.

24 JUDGE KRATZ: Well, again, that's an argument that
25 wasn't separately made in the main Brief.

26 MR. KRIEGER: It was.

1 JUDGE KRATZ: As to the process claims, and I think
2 we already asked you that question earlier, why do these process
3 claims stand on a different footing when that is only a product by
4 process limitation within the process claims, not really a process
5 limitation.

6 MR. KRIEGER: Well, I think some of the limitations
7 with respect to where the ADPA comes from, for example, the
8 residual, and talking about how you leave residual alkylated
9 diphenylamine in the mixture after the reaction to form the acridan,
10 those are process limitations in the process claims, and I think this
11 argument concerning the disclosure and exclusive disclosure in
12 Wheeler of purifying the acridan and then using the purified acridan
13 goes directly to that, and that was addressed in the Briefs and in the
14 arguments and the amendments throughout the prosecution history.

15 With respect to the composition claims, I think it's a
16 slightly different angle, because the, my understanding is that the
17 Board is not going to look at where the ADPA came from, but they
18 still cannot disregard this structural relationship between the two,
19 which is required by the process claims.

20 JUDGE KRATZ: I think we all looked at them
21 differently, that's what I was -- I'm not sure why we should look at
22 them differently when your process claims here, the only active step
23 is actually the adding step, where you're adding the mixture, and then
24 you describe where you get that mixture from, and that's where you
25 get your, it's a product of process limitation within the process

1 claims, and I'm not sure it has the same footing as you would have in
2 the product claim -- I don't see why it would have a different footing.

3 MR. KRIEGER: Well, the case law is clear that when
4 you do have process limitations, getting product by process claim,
5 that you have to consider that if they impart structure, and it's
6 appellant's position here that that is exactly the case here, because
7 again, if you read the process limitations in claim one, they require a
8 structural relationship. Again, the butylated octylated diphenylamine,
9 you have to have a butylated octylated acridan. That's just the way
10 you have to interpret the claim.

11 JUDGE NAGUMO: But you would concede that if we
12 wrongly in your view, I take it, found Wheeler fairly taught butylated
13 alkylated or octylated diphenylamine products, that there would be no
14 difference in the claimed product or in the claim process between
15 taking what your applicants have done and taking pure materials,
16 combining them, and then adding that to the, in your process claim.
17 If we had that, would you concede that you would then have to argue
18 for unexpected results, for example?

19 MR. KRIEGER: I think if Wheeler did describe the
20 formation of butylated octylated acridan compounds, and there was
21 appropriate rationale provided for why one would combine that with
22 a similar butylated octylated diphenylamine, that I would agree with
23 that. And although these have not been presented, because obviously
24 our position here is that a prima facie case of obviousness has not
25 been established, and the burden has not been shifted to us to show
26 surprising expected results. Surprising expected results have been

1 shown in the Specification, with respect to the combination of these
2 two compounds. So I would agree with that, if that was spelled out
3 such that way in a rejection.

4 JUDGE PAK: Thank you for coming.

5 MR. KRIEGER: Thank you very much.

6 Whereupon, the hearing was concluded at 10:22 a.m.

7